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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/752,564	01/03/2001	Hirofumi Sakaue	32405W061	9797

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EXAMINER

STRIMBU, GREGORY J

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/752,564

Applicant(s)

SAKAUE ET AL.

Examiner

Gregory J. Strimbu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Election/Restrictions***

Claims 14-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in Paper No. 10.

Applicant's election with traverse of Group I in Paper No. 10 is acknowledged. The traversal is on the ground(s) that the previous examiner examined all of the claims. This is not found persuasive because there is no evidence of record that the examiner did in fact examine claims 14-16. First, claims 14-16 were presented after the first office action of December 28, 2001 and no subsequent office action was issued by the previous examiner. Additionally, there is no record of the conversation of May 2, 2002 was indeed an interview discussing the merits of the application. Neither the examiner nor the applicant has presented an interview summary stating what transpired during the conversation of May 2, 2002. It is unclear to the examiner why the applicant has not submitted an interview summary detailing what was discussed and agreed to if the conversation of May 2, 2002 was in fact an interview. The requirement is still deemed proper and is therefore made FINAL.

***Specification***

The disclosure is objected to because of the following informalities: on line 3 of page 2, it is suggested that the applicant change "13" to --12-- since there is no figure 13 in the application; in the amendment to page 8, line 19, submitted on March 27, 2002, it appears that the phrase "spahed" is a typographical error.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites that the gas stay is disposed approximately in parallel with the connecting rod throughout movement of the hinge arm on lines 15-16. It should be noted that the specification does not provide support for the limitation. See page 5, lines 10-14 and page 18-21 wherein the movement of the hinge arm is never mentioned. Additionally, it appears from the drawings that the gas stay and the connecting rod cannot be disposed in parallel. See figure 2 wherein the gas stay 50 and the connecting rod 46 are not in parallel. Also, see figure 3 wherein it would appear that the longitudinal axes of the gas stay 50 and connecting rod 46 would cross when the rear gate 20 is in an open position.

Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Recitations such as "said vehicle body" on line 7 of claim 1 render the claims indefinite because they lack antecedent basis. Recitations such as "said power source" on line 2 of claim 3 render the claims indefinite because it is unclear if the applicant is referring to the power source unit set forth above or is setting forth another power source. Recitation such as "an operating signal" on line 6 of claim 4 render the claims indefinite because it is unclear if the applicant is referring to the operating signal set forth above or is attempting to set forth another signal in addition to the one set forth above. Recitations such as "opening speed" on line 3 of claim 6 render the claims indefinite because it is unclear what element of the invention has the speed to which the applicant refers.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Publication No. 41 24 869. German Patent Publication No. 41 24 869 discloses an apparatus comprising a power source unit 9 that produces power, a slider 12 that transforms the power into a reciprocating motion, a hinge arm 3, a connecting rod 20 that interlocks the slider and the hinge arm, the rod transmitting the reciprocating motion to the hinge arm, a mounting base 6 that supports the power source unit and the

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slider, a mounting base installer 22, and a gas stay 5 attached to the hinge arm at one end, and disposed at substantially the same height as and approximately in parallel with the connecting rod throughout movement of the hinge arm.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, 8, 9, 11, 12, 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent Publication No. 41 24 869 as applied to claims 1 and 2 above, and further in view of Hellinga et al. Hellinga et al. discloses a clutch 5, a position detector (not numbered, but see column 6, lines 15-22), a manipulator 8, a controller 7, a handle switch 24

It would have been obvious to one of ordinary skill in the art to provide German Patent Publication No. 41 24 869 with a clutch, a position detector, a manipulator, a controller, as taught by Hellinga et al., to enable a user to manually operate the closure and to accurately and safely move the closure

Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent Publication No. 41 24 869 in view of Hellinga et al. as applied to claims 3, 4, 8, 9, 11, 12, 13 and 17 above, and further in view of Kato. Kato discloses an

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apparatus having a controller 2 that controls an opening and closing speed of the closure D.

It would have been obvious to one of ordinary skill in the art to provide German Patent Publication No. 41 24 869 with a speed controller, as taught by Kato, to ensure the smooth movement of the closure between the open and closed positions.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over German Patent Publication No. 41 24 869 in view of Hellinga et al. as applied to claims 3, 4, 8, 9, 11, 12, 13 and 17 above, and further in view of Kowall et al. Kowall et al. discloses an rear lift gate apparatus having an alarm 52.

It would have been obvious to one of ordinary skill in the art to provide German Patent Publication No. 41 24 869, as modified above, with an alarm, as taught by Kowall et al., to enable a user to know an object is obstructing the movement of the closure.

### ***Response to Arguments***

Applicant's arguments filed February 10, 2003 have been fully considered but they are not persuasive.

With respect to the conversation with examiner Cohen on May 2, 2002, the record still fails to indicate the substance of the conversation. The applicant's attention is directed to MPEP 713.04 which states:

Substance of Interview Must Be Made of Record

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A complete written statement as to the substance of any face-to-face, video conference, electronic mail or telephone interview with regard to the merits of an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview. See 37 CFR 1.133(b), MPEP § 502.03 and § 713.01.

37 CFR 1.133. Interviews: (b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office actions as specified in § 1.111 and 1.135.

37 CFR 1.2. Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt. The action of the U.S. Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews. It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, except where the interview was initiated by the examiner and the examiner indicated on the "Examiner Initiated Interview Summary" form (PTOL-413B) that the examiner will provide a written summary. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability. Examiners must complete an Interview Summary form PTOL-413 for each interview where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks.

As set forth above, the action of the Patent and Trademark Office is based exclusively on the written record in the Office and no attention will be paid to an alleged oral promise or understanding in relation to which there is a disagreement or doubt. The conversation of May 2, 2002 cannot be considered an "interview" because neither examiner Cohen nor the applicant has presented a written interview summary detailing the merits of the application and the reasons warranting favorable action and because there is disagreement regarding the Office action of December 28, 2001. Merely stating



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that the all of the changes presented in the amendment of May 7, 2002 were suggested by examiner Cohen and agreed to by the applicant in the conversation of May 2, 2002, is not an interview summary. Because examiner Cohen failed to provide an interview summary, the duty falls to the applicant and requires the applicant to clearly point out the patentable novelty which the claims present in view of the state of the art disclosed by the references cited and to show how the amendments avoid such references or objections. The applicant is reminded that an interview does not remove the necessity for reply to Office actions as specified in 37 CFR 1.111 and 1.135. In addition, the changes submitted May 7, 2002 are not merely editorial in nature, as alleged by the applicant, because the recitation "throughout movement of the hinge arm" presents new matter and appears to have been made in an attempt to place the case into a condition for allowance. Moreover, the examiner has given full faith and credit to the search and action of the previous examiner, however, the examiner cannot give any credit to the conversation of May 2, 2002 because it was not an interview. Finally, there is clear error in the previous Office action and knowledge of the prior art. As noted in the rejection above, German Patent Publication No. 41 24 869 anticipates claims 1 and 2.

With respect to the applicant's comments concerning the rejection under 35 USC 112, first paragraph, the examiner respectfully disagrees. Page 12, lines 18-20 fail to mention the movement of the hinge arm. At best, lines 18-20 of page 12, set forth the gas stay being approximately in parallel with the connecting rod at some position of the hinge arm. Additionally, it should be noted that the applicant's response has not refuted the examiner's assertion that figure 2 shows the gas stay and the connecting rod in a

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non-parallel orientation and that figure 3 shows the longitudinal axes of the connecting rod and the gas strut intersecting when the gate is in a open position.

***Conclusion***

**THIS ACTION IS NOT MADE FINAL.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Strimbu whose telephone number is 703-305-3979. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.



Gregory J. Strimbu  
Primary Examiner  
Art Unit 3634  
April 23, 2003